

Attorney Docket #PDNO 10011474-1

Remarks/Arguments

Claims 1-15 and 17-20 remain in this application. Claims 1 and 15 have been amended.

A. Examiner's Remarks

Claims 1-6 and 13 were rejected under 35 U.S.C. § 102 (b) as being anticipated by USPN #4,834,519 to Twisselmann. Claim 7 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Twisselmann in view of USPN #5,425,238 to Takagi. Claims 8 and 10 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Twisselmann in view of USPN #6,499,374 to Ohga. Claim 9 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Twisselmann in view of Ohga and further in view of Takagi. Claims 11 and 12 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Twisselmann in view of USPN #6,170,795 to Wayne.

Claims 15 and 17 were rejected under 35 U.S.C. § 102 (b) as being anticipated by USPN #5,946,127 to Nagata.

Claims 14 and 18 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

B. Patentability of independent claim 1

Claims 1-6 and 13 were rejected under 35 U.S.C. § 102 (b) as being anticipated by USPN #4,834,519 to Twisselmann.

Twisselmann teaches a joint ball 15 that sits in a housing 10. The joint ball serves as a pivot mechanism for a suspension mount 51. The suspension mount 51 supports a microscope 50. The joint ball can be locked into place with clamping elements such as balls 13. The joint ball taught by Twisselmann is not adapted to contain anything within the joint ball. The joint ball only serves as a lockable pivot mechanism.

Attorney Docket #PDNO 10011474-1

Twisselmann does not teach an optical element, or any other object, contained within the joint ball itself.

In distinct contrast to Twisselmann, the present invention teaches a sphere adapted to contain an optical element (pg 6, paragraph 22). Figures 2A & 2B show the sphere having openings and spaces for containing an optical element. This unique and patentable distinction is recited within claim 1, as amended: "An optomechanical system comprising: a sphere adapted to contain an optical element...".

Independent claim 1 is believed to be allowable. Dependent claims 2-14 are also believed to be allowable, based on the allowability of claim 1. No new matter has been introduced with this amendment. The rejections to claims 1-14 are believed to be overcome.

C. Patentability of independent claim 15

Claims 15 and 17 were rejected under 35 U.S.C. § 102 (b) as being anticipated by USPN #5,946,127 to Nagata.

Nagata teaches an image pick-up apparatus such as a robotic eye, wherein a sphere 15 containing an image sensor is used to track a moving object. Nagata teaches a first magnet in contact with the sphere, and a second magnet that controls the movement of the sphere through its magnetic attraction to the first magnet. The magnetic attraction between the first and second magnet is relied upon to initiate and continue movement.

In distinct contrast to the prior art, the magnet attraction between the magnets and the sphere in the present invention are used to hold the sphere in place (Page 9, lines 1-2 of paragraph 31). The sphere can be moved only by overcoming this magnetic attraction, not by relying on it. This patentable distinction can be found in claim 15, as amended: "the magnets so constructed and arranged such that the sphere has freedom for prescribed movement when required by overcoming the magnetic attraction between the sphere and the magnets, but is otherwise held stationary by the magnetic attraction." (underlining added). Support for this amendment can be found in lines 1-7 of paragraph 32.

Independent claim 15 is believed to be allowable. Dependent claims 17-18 are believed to be allowable, based on the allowability of claim 15. No new matter has been

Attorney Docket #PDNO 10011474-1

introduced with this amendment. The rejections to claims 15 and 17 are believed to be overcome.

Attorney Docket #PDNO 10011474-1

Conclusion

If there are any further questions or if more discussion is required, the Examiner is invited to call the Applicant's agent at the telephone number given below. In view of the above, the claims presently in the application are believed to be distinct over the prior art and in condition for allowance. Accordingly, it is respectfully requested that such allowance be granted at an early date.

Respectfully submitted,
Kenneth J. Wayne, et al.

Jack H. Wu
Jack H. Wu
Patent Reg. No. 29,992

September 15, 2003
Agilent Technologies
Intellectual Properties Administration
Legal Department, M/S DL-429
815 SW 14th Street
Loveland, CO 80537
(408) 345-8920

OFFICIALRECEIVED
CENTRAL FAX CENTER

SEP 16 2003